

REMARKS

In the Final Office Action¹ mailed June 2, 2011, the Examiner:

- a) objected to claims 1, 10, and 18 because of informalities;
- b) rejected claims 1, 3-4, 6-10, 12, 14-18, and 23-26 under 35 U.S.C. 103(a) as being unpatentable over "*Kadel*" (U.S. Patent Application Publication No. 2002/0184401, in view of "*Severin*" (U.S. Patent Application Publication No. 2005/0005251 further in view of "*Worden*" (U.S. Patent Application Publication No. 2003/0149934); and
- c) rejected claims 20-22 under 35 U.S.C. 103(a) as being unpatentable over *Kadel*, *Severin*, *Worden* and *Hejlsberg* (U.S. Patent 6,920,461).

Applicant amends claims 1, 3, 4, 10, 18, and 20-23. Support for the amendments can be found in the specification and claims as originally filed. In light of the claim amendments made herein and for the reasons stated below, Applicants request reconsideration and removal of the rejections, and allowance of the claims.

Advisory Action

Applicant thanks the Examiner for the Advisory Action dated September 20, 2011. Below Applicant addresses issues raised by the Examiner in the Advisory Action, insofar as those issues are understood.

First, in response to the Examiner's concerns articulated on page 2 of the Advisory Action, Applicant has amended independent claims 1, 10, and 18 to remove any mention of an "API" from the preamble. If any further amendments are necessary,

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

the Examiner is respectfully requested to contact Applicant's undersigned representative.

Second, the Examiner also asserts on page 2 of the Advisory Action that:

[the metadata API 130 is] not a directly a derivation from the generated code but rather use as a tool provider or a container for said generated code (using Java inputs) to derive proxies, state classes or marshalling code or XML. In short, the metadata API being development container to generate more proxies, state classes or marshalling code cannot be views as a result from deriving anything from the generated code (using Java objects as input) since the Disclosure clearly state that the generated code is included in this API 130.

These assertions are incorrect, insofar as they are understood. Here the Examiner seems to reiterate a definition of "derivation" that has no basis in the instant specification or in the cited art. In the above quotation, the Examiner appears to insist that because "the Disclosure clearly state[s] that the generated code is included in this API 130" (emphasis added), the generation of the generated code cannot be part of a "derivation" of the metadata API. This is not correct. There is no basis for this assertion in the specification or the cited art. If the Examiner insists otherwise, Applicant respectfully requests that the Examiner cite the source for this assertion and/or explain its basis. More specifically, Applicant respectfully requests that the Examiner cite the basis for asserting that being "included" in an element and being part of a "derivation" of that element are mutually exclusive.

On page 2 of the Advisory Action, the Examiner argues:

In reply to the assertion that *Severin* does not teach 'deriving a API' thereby fails to remedy to *Kadel*, the Office action has presented a combination of teachings; and attacking piecemeal one reference at a time cannot be sufficient to show non-obviousness.

Applicant respectfully submits that Applicant has shown that this claimed element "deriving an API" is absent from the entire combination of references, rather than merely absent from *Severin*.

In the Amendment After Final, Applicant addressed the absence of the claimed "deriving an API" in every reference of the Examiner's proposed combination of *Kadel*, *Severin*, and *Worden*. On page 12 of the Amendment After Final, Applicant addressed the absence of "deriving an API" in *Kadel*. On pages 12-14 of the Amendment After Final, Applicant addressed the absence of the claimed feature in "combination of *Severin* and *Worden*" (Amendment After Final, page 12). Applicant specifically pointed out on page 13 of the Amendment After Final that the Examiner has failed to identify any feature of *Worden* in the proposed combination, much less to assert that *Worden* makes up for the admitted deficiencies of *Kadel* with respect to "deriving an API." On page 14 of the Amendment After Final, Applicant specifically addressed the absence of "deriving an API" in *Severin*. Therefore, Applicant has shown that this claimed element is absent from the entire combination of *Kadel*, *Worden*, and *Severin*, rather than merely absent from *Severin*, as the Examiner contends on page 2 of the Advisory Action.

Formal Matters

Claims 1, 10, and 18 are objected to because of informalities. More specifically, the Examiner alleges on page 2 of the Final Office Action "the term recited as 'deriving' is not construed as having proper teaching that substantially support a accepted (lexicographic)." The Applicant respectfully traverses the objection, insofar as the objection is understood and insofar as it may apply to the claims, as amended, for the

reasons provided in the Amendment After Final. More specifically, as discussed in the Amendment After Final, at least paragraph [0074] and FIG. 11 of the originally filed specification provide explicit support for this claimed feature. Although the Examiner argues that "includ[ing]" the generation code in the metadata API 130 implies that its generation cannot be part of the "derivation" of the metadata API 130 (Advisory Action, page 2), there is no basis for such an assertion.

Accordingly, Applicant respectfully submits that the objections to claims 1, 10, and 18 should be withdrawn.

Rejection Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection under 35 U.S.C. 103(a) of claims 1, 3-4, 6-10, 12, 14-18, and 23-26 as being unpatentable over *Kadel*, *Severin*, and *Worden*. A *prima facie* case of obviousness has not been established, at least with respect to the claims as amended.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." *M.P.E.P.* § 2142, 8th Ed. (July 2010)(*internal citation and inner quotation omitted*). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." *M.P.E.P.* § 2141(II). In rejecting a claim, "Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). Here, no *prima facie* case of obviousness has been established for at least the reason that the scope and content of the prior art have not been properly determined nor have the differences between the claimed invention and the prior art been properly ascertained.

Claim 1 recites, in part, a computer-readable storage device storing a computer program product being operable to cause:

generat[ion of] code using the set of intermediate objects as inputs to derive a metadata Application Program Interface (API), the metadata API enabling development tools to access the development objects to develop the application (emphasis added).

The cited art fails to disclose or suggest at least these elements of claim 1, as amended.

The Examiner correctly concedes on page 7 of the Final Office Action that:

Kadel does not explicitly disclose using the set of intermediate object as inputs to derive API code for enabling access and development objects (see Claim Objections).

On pages 7-9, the Examiner apparently attempts to cure this deficiency with a combination of *Severin* and *Worden*. However, there is no teaching in either *Severin* or *Worden* of "using the set of intermediate objects as inputs to derive a metadata Application Program Interface (API)," as claimed.²

² The Examiner has admitted that this feature is not taught in *Kadel* (see Office Action, page 7) and does not cite *Worden* as providing the claimed feature.

Worden discloses "us[ing] a set of mappings between XML logical structures and business information model logical structures" (*Worden*, abstract). *Worden* does discuss APIs in the context of "us[ing] mappings for a language to translate class-model-based API calls into XML structure accesses for the language"(*Worden*, paragraph [0034]). In paragraph [0045], *Worden* discloses:

Hence, this invention **covers an interface layer using the set of mappings described above** and providing an API which insulates code written in a high level language which accesses or creates documents in XML based languages from the structure of those XML based languages (emphasis added).

Therefore, *Worden* discloses using "mappings" and an "interface layer" to "translate [...] API calls" and not to "deriv[e] a metadata Application Program Interface (API)," as claimed. *Worden* thus fails to disclose "derive a metadata Application Program Interface (API)," much less the:

generat[ion of] code using the set of intermediate objects as inputs to derive a metadata Application Program Interface (API), the metadata API enabling development tools to access the development objects to develop the application,

as recited in amended claim 1.

Severin fails to make up for the deficiencies of *Kadel* and *Worden* with respect to the above-quoted feature of claim 1. *Severin* discloses a "Component Integration Engine" (title). *Severin* discloses in paragraph [0041] a "tool provid[ing] meta-implementations for many existing APIs" (emphasis added), not for "deriv[e] a metadata Application Program Interface (API)," as claimed. Paragraph [0042] of *Severin* further discloses "creating a meta-implementation descriptor for the existing APIs in a programming language." The Examiner cites paragraph [0107] of *Severin* as

disclosing this element. However, paragraph [0107] actually discloses "automatically convert[ing] any object to and from an XML metadata format," not "deriv[ing] a metadata Application Program Interface (API)," as claimed. Although paragraph [0107] mentions several types of format conversion (e.g., "to and from an XML metadata format," "convert from unknown XML formats to the expected metadata formats," "access XML in structured formats other than the standard metadata format to convert XML to objects and objects to XML), it does not disclose "deriv[ing...] API) enabling development tools," as claimed. Therefore, *Severin* fails to cure the deficiencies of *Kadel* and *Worden* at least with respect to:

generat[ion of] code using the set of intermediate objects as inputs to derive a metadata Application Program Interface (API), the metadata API enabling development tools to access the development objects to develop the application,

as recited in claim 1.

Accordingly the Final Office Action has failed to properly determine the scope and content of the prior art, and has failed to properly ascertain the differences between the prior art and the claimed combinations. For at least these reasons, no prima facie case of obviousness has been established for claim 1, and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a). Independent claims 10 and 18, as amended, recite similar elements as above and, therefore, the rejections under 35 U.S.C. 103 of these claims should be withdrawn for at least reasons similar to those given above with respect to claim 1.

Moreover, the rejections under 35 U.S.C. §103 of claims depending from independent claims 1, 10, and 18 are improper and should be withdrawn for at least reasons given above with respect to the independent claims.

Applicant also traverses the rejection of claims 20-22 under 35 U.S.C. §103 as being unpatentable over *Kadel*, *Severin*, *Worden* and *Hejlsberg*. A *prima facie* case of obviousness has not been established, at least with respect to the claims as amended.

Dependent claims 20-22 depend from independent claim 18 and include all the elements thereof. As set forth above, the combination of *Kadel*, *Severin*, and *Worden* fails to disclose at least:

generate code using the set of intermediate objects as inputs to derive a metadata API enabling development tools to access the development objects to develop the application,

as recited in independent claim 18 and included in dependent claims 20-22.

Hejlsberg fails to cure the deficiencies of the combination *Kadel*, *Severin*, and *Worden* at least with respect to the above-quoted element of independent claim 18.

The Office Action asserted on page 14 that *Hejlsberg* teaches:

Hejlsberg discloses a development application interface (analogous to *Kadel*) operating on layers or namespaces that expose class libraries or enumeration of related data structures or code constructs or tables (see *Hejlsberg*: col. 6; Fig. 2). Accordingly, *Hejlsberg* discloses application code instantiation from the libraries of reuse classes or OO packages (e.g. C++, Jscript, Microsoft ".NET" APIs) including UI objects with procedures to save a view, to customize drawing or drag-drop (col. 7, lines 48-62; col 8 lines 22-50) and a SQL namespace to interface with a database (col. 8 line 50 to col 9 line 11) including procedures to validate proper constructs, for implementing operations as to commit, dispose, rollback, save, accept/reject changes, cancel Edit (RejectChanges, acceptChanges - col 55; commit, delete, rollback - col. 57; CancelEdit col. 64; Delete, AcceptChanges - col. 65; Dispose, Finalize - col. 289; Commit, Dispose, Rollback, Save - col. 326).

Even if the assertions made by the Examiner were correct, which Applicant does not concede, *Hejlsberg* still fails to teach or suggest the above-quoted elements recited in

claim 18, as amended. Thus *Hejlsberg* does not compensate for the deficiencies of *Kadel*, *Severin*, and *Worden*.

In view of the deficiencies of the prior art set forth above, the Office has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, insufficient reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least these reasons, no *prima facie* case of obviousness has been established. Therefore, the rejection of dependent claims 20-22 under 35 U.S.C. §103 as being unpatentable over *Kadel*, *Severin*, *Worden* and *Hejlsberg*, insofar as it may apply to the claims as amended, is thus improper and should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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